

- 5 b) a side wall extending downwardly from the periphery of the top cover wall and configured to engage the rim portion of the food container, the side wall having: a first wall portion extending from the periphery of the top cover wall with a first lateral dimension measured between opposite sides thereof; a second wall portion having a second lateral dimension measured between opposite sides thereof, the second lateral dimension being greater than the first lateral dimension; and step portion connecting the first and second wall portions together wherein the second wall portion is configured to accept therein the first wall portion of another lid so as to enable a plurality of lids to be stacked in nested fashion; and,
- 10
- 15 c) a one-piece eating utensil located in the opening of the top cover wall, the one-piece eating utensil having an integral handle configured to be gripped by a hand of a user, the one-piece eating utensil being removably connected to the top cover wall solely by a plurality of discrete, spaced apart, frangible connecting elements.--

REMARKS

Claim Rejections

Claims 1-15 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Schoenmakers et al. (WO, 95/07847). Claims 3 and 10 stand further rejected under 35 U.S.C. § 103(a) as being rendered obvious by the aforementioned reference to Schoenmakers taken further in view of Chamourian (4,886,184).

In addition, the Examiner has objected to the Abstract of the Disclosure and to the drawings.

Drawings

Applicants propose to amend Figures 2, 3 and 4 as illustrated in red on the attached photocopy. The proposed amendments include properly cross-hatching the aforementioned views to indicate a plastic material. It is believed that the foregoing proposed amendments obviate the outstanding objection to the drawings. Approval of the proposed drawing changes is respectfully requested.

Abstract of the Disclosure

Applicants have corrected the Abstract of the Disclosure as noted by the Examiner on page 2 of the outstanding Office Action. This amendment is believed to obviate the outstanding objection to the Abstract of the Disclosure.

Claims

By this Amendment, Applicants have amended claims 1, 2 and 9 and have canceled claims 3 and 10. The subject matter of canceled claims 3 and 10 has been incorporated into amended claims 1 and 9, respectively. Claim 1 has been further amended to denote that the one-piece utensil has a food engaging portion of substantially uniform thickness, as clearly illustrated in Applicants' Figures 2-4. Applicants' specification, on page 3, line 15 and on page 5, line 2, specifically notes that the handle portion may have ribs. Thus, claims 1, 2 and 4-8 now specifically require the food engaging portion to have a substantially uniform thickness.

Applicants submit that the amended claims define subject matter that is patentably distinguishable over the cited prior art references, taken individually or in combination. While the cited reference to Schoenmakers shows a container lid having a one-piece eating utensil removably attached thereto, in all of the embodiments disclosed in this reference, the food engaging portion of the eating utensil is specifically required to have a non-uniform thickness. The non-uniform thickness of the food engaging portion is clearly illustrated in Schoenmakers' Figures 4 and 6, and described in Schoenmakers' specification, beginning on page 5. Schoenmakers specifically states, on page 5, lines 27 et seq. that:

The spoon 8 comprises a handle portion 16 and a bowl portion 17. The upper surface 18 of the spoon 8 is flat and flush with the flat upper surface 10 of the cover portion 2. A strengthening rib 21 is provided in the lower surface 19 of the spoon 8 and runs around the perimeter of the spoon 8. Another strengthening rib 23 extends across the spoon to define the border between the handle portion 16 and the bowl portion 17.

Additional strengthening ribs 22 are provided in the underside of the handle portion 16.

The lower surface of the bowl portion is of dished shape having a thinner central region at 24, and a thicker outer region at 25.

Although the remaining embodiments of Schoenmakers disclose various ways of attaching the utensil to the cover, the structure of the eating utensil does not vary among the various embodiments. Schoenmakers note that like numerals denote like parts throughout the application (see page 6, line 30). Thus, the embodiment illustrated in Figures 8-11 refer to the spoon as the same reference number as in the embodiment illustrated in Figures 1-7, which has the features quoted above. Indeed, in all of the remaining embodiments of Schoenmakers, the spoon is referred to the identical identifying number, as is the handle and eating utensil portion.

It is further submitted that Schoenmakers is totally devoid of even the remotest suggestion of the nesting capabilities of the lid configuration. It is well settled that a foreign reference cited under 35 U.S.C. § 102, teaches only that which is explicitly disclosed. Schoenmakers specifically discloses an eating utensil of non-uniform thickness and is totally devoid of any disclosure relating to the nesting capabilities of the lid. Thus, Applicants submit that Schoenmakers could not possibly anticipate any of Applicants' amended claims under 35 U.S.C. § 102. The outstanding rejection of Applicants' claims as being anticipated by Schoenmakers is respectfully traversed.

The secondary reference to Chamourian was cited for its disclosure of a plastic container lid teaching the stacking of a plurality of lids in nested fashion. Applicants note that Chamourian is totally devoid of any disclosure of any type of eating utensil incorporated into, or attached to the container lid. It is noted that neither Schoenmakers, nor Chamourian suggest, in any fashion whatsoever, the combination of features required by Applicants' claims, specifically the one-piece eating utensil having substantially uniform thickness in a lid configured to have a side wall that facilitates the nesting storage of the lids. Schoenmakers is totally

devoid of any suggestion of the desirability of incorporating these features into the disclosed lid configuration, while Chamourian is equally devoid of any suggestion that the disclosed container lid could contain any type of eating utensil. Clearly, neither of these references teaches that they could be combined as suggested by the Examiner.

It is a basic principle of U.S. patent law that it is improper to arbitrarily pick and choose prior art patents and combine selected portions of the patents on the basis of Applicants' disclosure to create a hypothetical combination which allegedly renders a claim obvious, unless there is some direction in the selected prior art patents to combine the selected teachings in a manner to negate the patentability of the claimed subject matter. This principle was enunciated over 40 years ago by the Court of Customs and Patent Appeals in In re Rothermel and Waddell, 125 USPQ 328 (CCPA 1960) wherein the court stated, at page 331:

The examiner and the board in rejecting the appealed claims did so by what appears to us to be a piecemeal reconstruction of the prior art patents in the light of appellants' disclosure. ... It is easy now to attribute to this prior art the knowledge which was first made available by appellants and then to assume that it would have been obvious to one having the ordinary skill in the art to make these suggested reconstructions. While such a reconstruction of the art may be an alluring way to rationalize a rejection of the claims, it is not the type of rejection which the statute authorizes.

The same conclusion has been reached by the Court of Appeals for the Federal Circuit. In Orthopedic Equipment Company Inc. v. United States, 217 USPQ 193 (Fed.Cir. 1983), the court stated, at page 199:

As has been previously explained, the available art shows each of the elements of the claims in suit. Armed with this information, would it then be non-obvious to this person of ordinary skill in the art to coordinate these elements in the same manner as the claims in suit? The difficulty which attaches to all honest

attempts to answer this question can be attributed to the strong temptation to rely on hindsight while undertaking this evaluation. It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. Monday morning quarterbacking is quite improper when resolving the question of non-obviousness in a court of law.

More recently, the court has held, in In re Fritch, 23 USPQ2d, 1780 (Fed.Cir. 1992), at page 1783 that:

The mere fact that the prior art may be modified in the manner suggested by the examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

Applicants submit that absent any teaching in the prior art references of the desirability of combining their respective teachings, Chamourian cannot be combined with Schoenmakers, as suggested by the Examiner, under 35 U.S.C. § 103. It is further submitted that neither of these references remotely suggest the concept of a substantially uniform thickness food engaging portion as specifically required by Applicants' claims 1, 2 and 4-8. Thus, even if the references could be combined, the resultant combination would be devoid of this feature. Clearly, such a combination of references could not possibly render obvious any of Applicants' claims 1, 2 and 4-8.

Version With Markings To Show Changes Made

Attached hereto is a marked-up version of the changes made to the application by the current amendment. The attached document is captioned VERSION WITH MARKINGS TO SHOW CHANGES MADE.

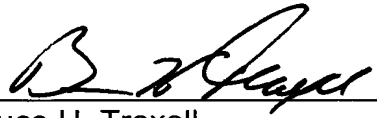
Summary

In view of the foregoing amendments and remarks, Applicants submit that this application is now in condition for allowance and such action is respectfully requested. Should any points remain in issue, which the Examiner feels could best be resolved by either a personal or a telephone interview, it is urged that Applicants' local attorney be contacted at the exchange listed below.

Respectfully submitted,

Date: September 23, 2002

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE ABSTRACT:

The Abstract has been amended as follows, and a substitute Abstract is being submitted herewith:

ABSTRACT OF THE DISCLOSURE

A [lid is disclosed that] is configured to be mounted on a food container having a rim bounding an opening of the food container. The lid has a top cover wall with a through opening and an outer periphery, a one-piece eating utensil being located in the opening of the top cover wall and connected to the top cover wall by a plurality of discrete, spaced apart, frangible connecting elements. The one-piece utensil has a food engaging portion and an integral handle portion, the handle portion being configured to be gripped by a hand of a user. The length of the one-piece eating utensil, measured from an end of the food engaging portion to an opposite end of the handle portion, is less than a distance between opposite sides of the periphery of the top cover wall such that the one-piece eating utensil fits entirely within the periphery of the top cover wall. A side wall extends downwardly from the periphery of the top cover wall and is configured to engage the rim portion of the food container.

IN THE CLAIMS:

Claims 3 and 10 have been canceled.

Claims 1, 2 and 9 have been amended as follows:

1. (Amended) A lid configured to be mounted on a food container having a rim bounding an opening of the food container, the lid comprising:
 - a) a top cover wall having a generally planar configuration, the top cover wall having an opening therethrough and an outer periphery;

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5 b) a one-piece eating utensil located in the opening of the top cover wall, the one-piece utensil having a food engaging portion of substantially uniform thickness and an integral handle portion extending therefrom, the handle portion being configured to be gripped by a hand of a user, the one-piece eating utensil being removably connected to the top cover wall solely by a plurality of discrete, spaced
10 apart, frangible connecting elements, a length of the one-piece eating utensil from an end of the food engaging portion to an end of the handle portion being less than a distance between opposite sides of the periphery of the top cover wall; and,

 c) a side wall extending downwardly from the periphery of the top cover wall and configured to engage the rim portion of the food container, the side wall
15 including first and second wall portions wherein the second wall portion of one lid is configured to accept therein the first wall portion of another lid so as to enable a plurality of lids to be stacked in nested fashion.

2. (Amended) The lid of claim 1 wherein [the side wall comprises]:

a) [a] the first wall portion [extending] extends from the periphery of the top cover wall;

b) [a] the second wall portion [having] has a lateral dimension measured
5 between opposite sides thereof greater than a corresponding dimension of the first wall portion; and,

c) a step portion connecting the first and second wall portions together.

4. The lid of claim 1 wherein the food engaging portion comprises a spoon.

5. The lid of claim 1 wherein the food engaging portion comprises a fork.

6. The lid of claim 1 wherein the food engaging portion comprises a knife.

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7. The lid of claim 1 further comprising a protective sheet attached to the top cover wall and covering at least the one-piece eating utensil.

8. The lid of claim 7 wherein the protective sheet is removably attached to the top cover wall.

9. (Amended) A lid configured to be mounted on a food container having a rim bounding an opening of the food container, the lid comprising:

a) a top cover wall having a generally planar configuration, the top cover wall having an opening therethrough and an outer periphery;

5 b) a side wall extending downwardly from the periphery of the top cover wall and configured to engage the rim portion of the food container, the side wall having: a first wall portion extending from the periphery of the top cover wall with a first lateral dimension measured between opposite sides thereof; a second wall portion having a second lateral dimension measured between opposite sides
10 thereof, the second lateral dimension being greater than the first lateral dimension; and step portion connecting the first and second wall portions together wherein the second wall portion is configured to accept therein the first wall portion of another lid so as to enable a plurality of lids to be stacked in nested fashion; and,

15 c) a one-piece eating utensil located in the opening of the top cover wall, the one-piece eating utensil having an integral handle configured to be gripped by a hand of a user, the one-piece eating utensil being removably connected to the top cover wall solely by a plurality of discrete, spaced apart, frangible connecting elements.

11. The lid of claim 9 wherein the food engaging portion comprises a spoon.

12. The lid of claim 9 wherein the food engaging portion comprises a fork.

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13. The lid of claim 9 wherein the food engaging portion comprises a knife.

14. The lid of claim 9 further comprising a protective sheet attached to the top cover wall and covering at least the one-piece eating utensil.

15. The lid of claim 14 wherein the protective sheet is removably attached to the top cover wall.

